

over the combination of Yamamoto and Imaizumi U.S. Patent No. 6,215,512. These rejections are respectfully traversed.

Contrary to the Examiner's assertion regarding claim 1, Yamamoto does not disclose "an input device for inputting distortion data of the exposing unit." Although Yamamoto discloses "a circuit to correct the variations of the light emitting luminance of each LED," Yamamoto fails to provide a data input device to the image forming system as in the claimed invention. Similarly, Yamamoto fails to disclose distortion correction. This logic also disposes of claims 2 and 3 which depend directly or indirectly from claim 1.

The claim rejections under 35 USC 103(a) are also untenable because the combination constructed by the Examiner is not the claimed invention. Thus, the invention could not have been obvious, even in hindsight. Neither Sato nor Imaizumi disclose or suggest an image forming apparatus having an input device as in the claimed invention.

Additionally, Sato states (col. 6, lines 21-24) that correction on the basis of a variation of the light emitting elements (5) and the light receiving elements (7) can be performed on the operation panel (100). This statement relates to correction with respect to the light emitting elements (5) for emitting light onto an original, which is different than the "exposure unit which exposes an image carrier" as disclosed in applicant's invention. Therefore, there would be no motivation to apply the teachings disclosed in Sato to the present invention.

Even if the resulting combination suggested by the Examiner included all the claim limitations of claims 4 and 6-9, the cited references provide no evidence of a motivation to combine their disclosures so as to arrive at the claimed invention.

The Examiner states in the Action that persons of ordinary skill in the art would have been motivated by Sato and Imaizumi to modify the method disclosed in Yamamoto to arrive at the claimed invention. The Examiner's alleged motivation is so general in the context of the relevant art as to constitute no more than the reference to a general level of skill in the art found

deficient in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Under *Lee*, the Examiner must present *specific* evidence of motivation, not the kind of generalized allegation of motivation relied on in the pending Action:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the *Graham* factors).

The burden imposed by *Lee* is not an impossible burden, as explained by the court in *In re Thrift*, 298 F.3d 1357, 1364-65, 63 USPQ2d 2002, 2007 (Fed. Cir. 2002), with respect to the references relied on by the Board in that case:

In the present case, the reasoning articulated by the Board is exactly the type of reasoning required by *In re Lee*. Both the examiner and the Board clearly identified a motivation to combine the references, stating that the skilled artisan would have “found it obvious to incorporate the speech input and speech recognition techniques taught by Schmandt into the expert system of Stefanopoulos in order to reduce the need for less user friendly manual keyboard and mouse click inputs.” Decision on Appeal at 5; accord Aug. 7, 1996 Office Action at 3. The motivation to combine the references is present in the text of each reference. The Schmandt reference itself verifies this motivation, stating that “allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment.” Schmandt at 51. Stefanopoulos itself, while not expressly disclosing the use of speech recognition, sets forth the motivation to combine the references, stating that “there are alternative means to select the buttons, including . . . voice-activated transfer means, which may be readily adapted for use with the present invention by those skilled in the art.” ‘237 patent, col. 4, ll. 34-38.

The reliance in the pending Action on the alleged routine skill in the art to make the suggested combination comes nowhere close to what *Lee* and *Thrift* require. It is not sufficient to say without evidentiary support, as the Examiner does in the pending Action, “Yamamoto et al. could have easily been modified with the operation panel of Sato et al. This modification

would have been obvious to one skilled in the art at the time of the invention to input the distortion data of the image data.” The same argument applies to Imaizumi’s transfer unit, optical sensors and data processor. Yamamoto, Sato or Imaizumi neither use nor suggest all the features in applicant’s claimed inventions.

Finally, the Examiner has pointed to no disclosure in Sato, the alleged evidence of such a motivation, that would have motivated a person of ordinary skill in the art to use its supposed operation panel.¹ Applicant’s invention may be a straightforward and elegant solution to the problem it addresses, but the cited prior art is devoid of a suggestion to make it. Accordingly, the invention claimed is patentable over the prior art, and claims 4 and 6-9 should be allowed.

Finally, the Examiner objected to claim 5 as being dependent upon a rejected base claim. However, in view of the above arguments, each of the claims in this application is in condition for allowance. Accordingly, applicant solicits early action in the form of a Notice of Allowance.

¹ Applicant recognizes that an Examiner cannot search prior art to use in examining a patent application without reading the application and its claims first. That much “hindsight” is permissible and expected in the examination process. However, that is as far as hindsight in the examination process can go. Once the Examiner finds prior art that appears to be relevant based on the limited amount of hindsight that is permissible, *Lee* and *Thrift* require the Examiner to point to *evidence* within the prior art *itself* as to why persons of ordinary skill in the art would have been motivated to combine the disclosures so as to arrive at the claimed invention. Applicant’s position rests on the Examiner’s failure to produce and rely on objective evidence of motivation in the prior art itself.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Docket No. **325772022400**.

Respectfully submitted,

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